

Remarks

The Office Action of June 3, 2008 and cited prior art references were reviewed with care in the preparation of this response.

After the above amendment, claims 77-84 and 86 are pending in the application.

Allowance of all claims, as adjusted, is respectfully requested.

Claims 77, 80-82, 84 and 86 were rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke and further in view of Baker. Claims 77, 80-82, 84 and 86 are now in condition for allowance, as set forth below.

Independent claim 77 has been somewhat adjusted to further highlight the already-present limitation that requires that the light body to have a *single* inner recess and that both the LED and the battery are secured withing such *single* recess. Independent claim 86 has been amended to include the same thing. These amendments should not prompt any new search because no new element has been added; rather, the previously examined and searched limitation is simply emphasized.

Most important, applicant respectfully disagrees with the Examiner's assertion that the Cooper et al. patent discloses "the light body having a tool facing section and a *single* inner recess." To the contrary, the inspection light of the Cooper et al. patent, as shown in Figure 8, has a battery housing 68 with a threaded top for releasably engaging a screw cap 71, and a lamp assembly 72 which is also releasably attached to the opposite end of the screw cap 71. Each of the battery housing and lamp assembly is independently separable from the screw cap positioned therebetween. Therefore, the LED and batteries are in separate compartments and not within the *single* inner recess, as required by the applicant's claims. This is in addition to the fact that, in the inspection light of the Cooper et al. patent, the LED lamp is not within any inner recess at all, but freely extends through the forward end of the lamp housing.

The Baker lighted mirror has a battery compartment 10 and has its incandescent bulb in a separate light casing 42. The Baker lighted mirror does not have a *single* inner recess with an LED and a battery both secured within such *single* inner recess.

It can be seen that none of the references, alone or in combination, has a single recess containing both the LED and the battery. It is clear that the rejection does not establish a *prima facie* case of obviousness and should be withdrawn. Independent claim 77 with all its dependent claims, including claims 80-82 and 84, and independent claim 86, as adjusted, are patentably distinct over the Cooper et al., Blaschke and Backer, alone or in combination.

Furthermore, applicant once again points out that, as set forth in applicant's November 26, 2007 response, the Cooper et al. and Blaschke references may not be combined properly as a basis for rejecting applicant's claims. The modification proposed by the Examiner would interfere with the ability of the Copper et al. lamp to be inserted into small spaces for needed inspection of suspected leaks; and the net would greatly interfere with the visibility of the inspected areas. And, the Blaschke device would be rendered inoperable by the Examiner's proposed modification. Placing a light in the distal end of the handle of the Blaschke net would prevent retraction of the net into the handle; *i.e., a light at that location would destroy the central purpose of the Blaschke net.*

MPEP 2143.01, paragraph V, titled "The Proposed Modification Cannot Render the Prior Art Unsatisfactory for its Intended Purpose," provides that "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification" (*In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).¹ As shown above, the proposed modification would render the prior art being modified unsatisfactory for its intended purpose, so there can be no suggestion or motivation to make such proposed modification. Thus, obviousness cannot properly be established. Directly on point is MPEP 2143.01, paragraph I, provides that, "Obviousness can only be established by combining or modifying the teachings of the prior art to

¹MPEP 2143.01, paragraph IV, provides that, "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 US at ___, 82 USPQ2d at 1396, quoting *In re Kahn*, 441 F.3d 977, 088, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)."

produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)."

Claim 78 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Baker and further in view of Schiao. This rejection is respectfully traversed in view of the above comments and arguments with respect to claim 77 upon which this claim depends. Claim 78 is in condition for allowance.

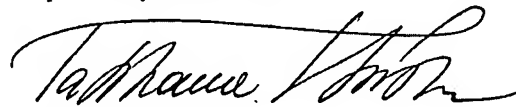
Claim 79 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Backer, Shiao and further in view of Lebens et al. This rejection is respectfully traversed in view of the amendment of independent claim 77, upon which this claim depends, and in view of the above comments. The Lebens et al. patent does not disclose a *single* inner recess with an LED and a battery both secured within such single inner recess, as required by amended claim 77. Therefore, claim 79 is in condition for allowance.

Claim 83 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Baker and further in view of Brundage et al. This rejection is respectfully traversed in view of the amendment of independent claim 77, upon which this claim depends, and in view of the above comments. Brundage et al. does not disclose a *single* inner recess with an LED and a battery both secured within such single inner recess, as required by amended claim 77. Therefore, claim 83 is in condition for allowance.

In view of the above, allowance of this application is hereby requested. The Examiner is invited to call attorney Peter Jansson or the undersigned to resolve any issues that might remain.

Date: September 3, 2008

Respectfully submitted,



Tatstsana V. Fenster
Registration No. 62,320

Jansson Shupe & Munger Ltd.
245 Main Street
Racine, WI 53403
Telephone: (262) 632-6900
Facsimile: (262) 632-2257